

ESTTA Tracking number: **ESTTA486491**Filing date: **07/31/2012**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

**Petitioner Information**

Name	BHPC ASSOCIATES LLC		
Entity	limited liability corporation	Citizenship	Delaware
Address	1370 Broadway New York, NY 10018 UNITED STATES		

Attorney information	Robert L. Epstein Epstein Drangel LLP 60 East 42nd Street, Suite 2410 New York, NY 10165 UNITED STATES mail@ipcounselors.com Phone:2122925390
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**Registration Subject to Cancellation**

Registration No	2525322	Registration date	01/01/2002
Registrant	Royal County of Berkshire Polo Club 26 Grosvenor Street London W1X 0RD, UNITED KINGDOM		

**Goods/Services Subject to Cancellation**

Class 025. First Use: 2000/04/12 First Use In Commerce: 2000/04/12 All goods and services in the class are cancelled, namely: clothing, footwear and headgear, namely, T-shirt, sleep wear, shirts, hats, shorts, sweat bands, sweat pants, sweat shirts, sweat shorts, sweat suits, socks and sweaters, belts
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**Grounds for Cancellation**

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Abandonment	Trademark Act section 14

Attachments	073112 Petition for Cancellaiton - color.pdf ( 23 pages )(7324480 bytes )
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**Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/robert l. epstein/
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Name	Robert L. Epstein
Date	07/31/2012


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BHPC ASSOCIATES LLC,	:	
	:	
Petitioner,	:	Cancellation No.
	:	
v.	:	
	:	
	:	
ROYAL COUNTY OF BERKSHIRE POLO	:	
CLUB	:	
	:	
Registrant.	x	



Petitioner, BHPC Associates LLC, of 1370 Broadway, New York City, New York 10018, believes that it is being damaged by Registration No. 2525322 issued January 1, 2002 for the trademark ROYAL BERKSHIRE POLO CLUB and Polo Player Design and therefore petitions to cancel said registration.

1. Continuously and long prior to the filing date of July 18, 1995 of Application Serial No. 74702872 upon which Registration No. 2525322 is based, Petitioner has offered and continues to offer a variety of goods, including clothing and footwear bearing the mark BEVERLY HILLS POLO CLUB and a design including the image of a polo player on horseback swinging his mallet (the “BEVERLY HILLS POLO CLUB and Polo Player Design mark”).

2. Over a prolonged period of time, Petitioner has invested a substantial amount of time, effort and money promoting its BEVERLY HILLS POLO CLUB and Polo Player Design mark and the goods bearing that mark. As a result of its promotional efforts, a tremendous volume of sales, and extensive use of the BEVERLY HILLS POLO CLUB and Polo Player Design mark, Petitioner's BEVERLY HILLS POLO CLUB and Polo Player Design mark has attained widespread acclaim in the United States, and has come to be exclusively recognized as identifying the products of Petitioner. Since long before any use of or alleged rights of Applicant in the mark hereby opposed, Petitioner's BEVERLY HILLS POLO CLUB and Polo Player Design mark has become distinctive of Petitioner's goods and represents a tremendous amount of goodwill of Petitioner's business.

3. In addition to its common law rights, Petitioner owns the following incontestable United States trademark registrations of the BEVERLY HILLS POLO CLUB and the Polo Player Design mark for use in the aggregate in connection with Petitioner's goods:

MARK	Class(es)	REGISTRATION NUMBER	REGISTRATION DATE
	25	1429311	02-17-1987

	09,14,18,24,25	1751058	02-09-1993
	25	2214846	12-29-1998

4. Petitioner's registrations are valid, subsisting, in full force and effect, incontestable, and are evidence of Petitioner's exclusive rights to use its registered marks on the identified goods, pursuant to 15 U.S.C. §§ 1057 and 1115.

5. Upon information and belief, Royal County of Berkshire Polo Club ("Registrant") filed with the United States Patent and Trademark Office an Application Ser. No. 74702872 dated July 18, 1995, for the trademark ROYAL BERKSHIRE POLO CLUB and Polo Player Design ("Registrant's Mark") for the following goods: "Clothing, footwear and headgear, namely, T-shirt, sleep wear, shirts, hats, shorts, sweat bands, sweat pants, sweat shirts, sweat shorts, sweat suits, socks and sweaters, belts" in International Class 025.



6. Upon information and belief, said Application Ser. No. 74702872 was allowed by the United States Patent and Trademark Office and issued into Registration No. 2525322 on January 1, 2002, the registration which Petitioner seeks to cancel.

7. Registrant is not connected to Petitioner in any way and has not been authorized by Petitioner to use the mark of Registration No. 2525322.

**COUNT I: FRAUD – DECLARATION OF USE UNDER SECTIONS 8 & 15**

8. Petitioner repeats and realleges each of the allegations set forth in Paragraphs 1 through 7 of the Petition above, as though same were fully set forth herein.

9. On December 26, 2007, Petitioner's attorney filed a Combined Declaration of Use and Incontestability under Sections 8 & 15 (the "Declaration of Use") on behalf of Registrant. A copy of the Declaration of Use is attached hereto as **Exhibit A**.

10. The Declaration of Use of Exhibit A filed on behalf of Registrant contained the following representations as to the use of Registrant's Mark: "...the mark is in use on or in connection with all goods or services listed in the existing registration for this specific class; and the mark has been continuously used in commerce for five (5) consecutive years after the date of registration...and is still in use in commerce on or in connection with all goods or services listed in the existing registration for this class..."

11. The Declaration of Use of Exhibit B, and the representations as to the use of the mark in commerce contained therein, were submitted on behalf of Registrant to induce the USPTO maintain Registration No. 2525322 in force and not to cancel Registration No. 2525322,

were relied upon by the USPTO in maintaining Registration No. 2525322 in force and not cancelling Registration No. 2525322, and the USPTO would not have maintained Registration No. 2525322 in force and canceled Registration No. 2525322, without same. Accordingly, the Declaration of Use of Exhibit A, and the representations as to the use of the mark in commerce contained therein submitted on behalf of Registrant were material to the continued registration of Registrant's mark.

12. Upon information and belief, as of December 26, 2007, the date of filing of the Declaration of Use of Exhibit A, Registrant's Mark was not in use on or in connection with all or some of the goods or services listed in Registration No. 2525322 for International Class 025.

13. Upon information and belief, as of December 26, 2007, the date of filing of the Declaration of Use of Exhibit A, Registrant's Mark had not been continuously used in commerce for five (5) consecutive years after the date of Registration No. 2525322 on all or some of the goods or services listed in Registration No. 2525322 for International Class 025..

14. Upon information and belief, as of December 26, 2007, the date of filing of the Declaration of Use of Exhibit A, Registrant's Mark was not still in use in commerce on or in connection with all or some of the goods or services listed in Registration No. 2525322 for International Class 025.

15. Upon information and belief, the representations as to the use of the mark in commerce contained in the Declaration of Use of Exhibit A were false.

16. Upon information and belief, the Declaration of Use of Exhibit A and the representations as to the use of the mark contained therein were made by or on behalf of Registrant with knowledge of the falsity thereof.

17. Upon information and belief, the Declaration of Use of Exhibit A and the representations as to the use of the mark contained therein were made by or on behalf of Registrant with a reckless disregard for the truth or validity thereof.

18. Upon information and belief the Declaration of Use of Exhibit A, and the representations as to the use of the mark contained therein, were made by or on behalf of Registrant with intent to deceive the USPTO into maintaining Registration No. 2525322 in force and not cancelling Registration No. 2525322, when it otherwise would not have maintained Registration No. 2525322 in force and would have cancelled Registration No. 2525322.

19. Upon information and belief, Registration No. 2525322 is invalid because it was maintained by fraud and should be cancelled in its entirety.

20. By reason of the foregoing, Petitioner will be damaged by the continued registration of the mark of Registration No. 2525322.

## **COUNT II: FRAUD – DECLARATION OF USE UNDER SECTIONS 8 & 9**

21. Petitioner repeats and realleges each of the allegations set forth in Paragraphs 1 through 20 of the Petition above, as though same were fully set forth herein.

22. On June 21, 2012, Petitioner's attorney filed a Combined Declaration of Use and/or Excusable Nonuse/Application for Renewal of Registration of a mark under Sections 8 & 9 (the "Renewal Declaration of Use") on behalf of Registrant. A copy of the Renewal Declaration of Use is attached hereto as **Exhibit B**.

23. The Renewal Declaration of Use of Exhibit B filed on behalf of Registrant contained the following representation: "The mark is in use in commerce on or in connection



with the following goods or services listed in the existing registration for this specific class; or, the owner is making the listed excusable nonuse claim: clothing and headgear, names, shirts, hats, sweat pants, sweat shirts, and socks”.

24. The Renewal Declaration of Use of Exhibit B filed on behalf of Registrant did not contain any excusable nonuse claim.

25. The Renewal Declaration of Use of Exhibit B, and the representations as to the use of the mark in commerce contained therein, were submitted on behalf of Registrant to induce the USPTO maintain Registration No. 2525322 in force and to renew Registration No. 2525322, were relied upon by the USPTO in maintaining Registration No. 2525322 in force and renewing Registration No. 2525322, and the USPTO would not have maintained Registration No. 2525322 in force and renewed Registration No. 2525322, without same. Accordingly, the Renewal Declaration of Use of Exhibit B, and the representations as to the use of the mark in commerce contained therein, submitted on behalf of Registrant were material to the continued registration of Registrant’s Mark.

26. Upon information and belief, as of June 21, 2012, the date of filing of the Renewal Declaration of Use of Exhibit B, Registrant’s Mark was in not use on or in connection with all or some of the following goods or services listed in Registration No. 2525322 for International Class 025: clothing and headgear, names, shirts, hats, sweat pants, sweat shirts, and socks.

27. Upon information and belief, the representations as to the use of the mark in commerce contained in the Renewal Declaration of Use of Exhibit B were false.

28. Upon information and belief, the Renewal Declaration of Use of Exhibit B and the representations as to the use of the mark contained therein were made by or on behalf of Registrant with knowledge of the falsity thereof.

29. Upon information and belief, the Renewal Declaration of Use of Exhibit B and the representations as to the use of the mark contained therein were made by or on behalf of Registrant with a reckless disregard for the truth or validity thereof.

30. Upon information and belief the Renewal Declaration of Use of Exhibit B, and the representations as to the use of the mark contained therein, were made by or on behalf of Registrant with intent to deceive the USPTO into maintaining Registration No. 2525322 in force and renewing Registration No. 2525322 when it otherwise would not have maintained Registration No. 2525322 in force and would not have renewed Registration No. 2525322.

31. Upon information and belief, Registration No. 2525322 is invalid because it was maintained and renewed by fraud and should be cancelled in its entirety.

32. By reason of the foregoing, Petitioner will be damaged by the continued registration of the mark of Registration No. 2525322.

### **COUNT III – ABANDONMENT**

33. Petitioner repeats and realleges each of the allegations set forth in Paragraphs 1 through 32 of the Petition above, as though same were fully set forth herein.

34. Upon information and belief, Registrant has not used Registrant's Mark in commerce on some or all of the goods identified in Registration No. 2525322.

35. Upon information and belief, Registrant has abandoned any right it may have, or may have had, to use Registrant's Mark on the goods identified in Registration No. 2525322.

36. Upon information and believe, Registrant has abandoned Registration No. 2525322.

37. Upon information and belief, Registration No. 2525322 is invalid because of abandonment and should be cancelled in its entirety.

38. By reason of the foregoing, Petitioner will be damaged by the continued registration of the mark of Registration No. 2525322.

**WHEREFORE**, it is respectfully requested that this petition for cancellation be sustained and that the Registration No. 2525322 be cancelled .

Respectfully submitted,

**EPSTEIN DRANGEL LLP**

By: 

Robert L. Epstein

William C. Wright

Jason M. Drangel

60 East 42<sup>nd</sup> Street, Suite 2410

New York, New York 10165

Tel. No.: (212) 292-5390

Fax. No.: (212) 292-5391

Dated: July 31, 2011

## EXHIBIT A



**Combined Declaration of Use and Incontestability Under Sections 8 & 15  
To the Commissioner for Trademarks:**

**REGISTRATION NUMBER:** 2525322

**REGISTRATION DATE:** 01/01/2002

**MARK:** ROYAL BERKSHIRE POLO CLUB (stylized and/or with design)

The owner, Royal County of Berkshire Polo Club, having an address of  
26 Grosvenor Street  
London W1X 0RD,  
United Kingdom

is filing a Combined Declaration of Use and Incontestability Under Sections 8 & 15.

For International Class 025, the mark is in use in commerce on or in connection with **all** of the goods or services listed in the existing registration for this specific class; **and** the mark has been continuously used in commerce for five (5) consecutive years after the date of registration, or the date of publication under Section 12(c), and is still in use in commerce on or in connection with **all** goods or services listed in the existing registration for this class. Also, no final decision adverse to the owner's claim of ownership of such mark for those goods or services exists, or to the owner's right to register the same or to keep the same on the register; and, no proceeding involving said rights pending and not disposed of in either the U.S. Patent and Trademark Office or the courts exists.

The owner is submitting one specimen for this class showing the mark as used in commerce on or in connection with any item in this class, consisting of a(n) A photograph of the product having the mark thereon..

**Original PDF file:**

[.pdf](#)

**Converted PDF file(s) (2 pages)**

[Specimen File1](#)

[Specimen File2](#)

The registrant hereby appoints Mark G. Kachigian of Head, Johnson & Kachigian  
228 West 17th Place  
Tulsa, Oklahoma 74119  
United States

to file this Combined Declaration of Use and Incontestability Under Sections 8 & 15 on behalf of the registrant. The attorney docket/reference number is BAI525-182/07463.

The registrant hereby appoints Mark G. Kachigian, having an address of  
228 West 17th Place  
Tulsa, Oklahoma 74119  
United States

as registrant's representative upon whom notice or process in the proceedings affecting the mark may be served.

A fee payment in the amount of \$300 will be submitted with the form, representing payment for 1 class(es), plus any additional grace period fee, if necessary.

### **Declaration**

*The owner, or its related company, is using the mark in commerce on or in connection with the goods and/or services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce. The owner, or its related company, has continuously used the mark in commerce on or in connection with the goods and/or services identified above, for five (5) consecutive years after the date of registration, or the date of publication under Section 12(c), and is still using the mark in commerce on or in connection with the identified goods and/or services. There has been no final decision adverse to the owner's claim of ownership of such mark for such goods and/or services, or to the owner's right to register the same or to keep the same on the register; and there is no proceeding involving said rights pending and not disposed of either in the U.S. Patent and Trademark Office or in the courts.*

The undersigned being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the Owner; and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

Signature: /markgkachigian/      Date: 12/26/2007

Signatory's Name: Mark G. Kachigian

Signatory's Position: Attorney

**Mailing Address (current):**

GRIMES & BATTERSBY, LLP  
488 Main Avenue 3rd Floor  
Norwalk, Connecticut 06851-1008

**Mailing Address (proposed):**

Head, Johnson & Kachigian  
228 West 17th Place  
Tulsa, Oklahoma 74119

Serial Number: 74702872

Internet Transmission Date: Wed Dec 26 14:08:00 EST 2007

TEAS Stamp: USPTO/S08N15-216.201.136.114-20071226140

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30813c3f58fd-DA-10950-200712261357144039











## EXHIBIT B

**Combined Declaration of Use and/or Excusable Nonuse/Application for Renewal of  
Registration of a Mark under Sections 8 & 9  
To the Commissioner for Trademarks:**

**REGISTRATION NUMBER:** 2525322

**REGISTRATION DATE:** 01/01/2002

**MARK:** (Stylized and/or with Design, ROYAL BERKSHIRE POLO CLUB)

The owner, Royal County of Berkshire Polo Club, a corporation of United Kingdom, having an address of  
North Street, Winkfield Windsor  
Berkshire, SL44TH  
United Kingdom

is filing a Combined Declaration of Use and/or Excusable Nonuse/Application for Renewal of  
Registration of a Mark under Sections 8 & 9.

For International Class 025, this filing does **NOT** cover the following goods or services for this specific  
class listed in the registration, and these goods or services are to be permanently **deleted** from the  
registration: footwear, T-shirt, sleep wear, shorts, sweat bands, sweat shorts, sweat suits, sweaters, belts

The mark is in use in commerce on or in connection with the following goods or services listed in the  
existing registration for this specific class; or, the owner is making the listed excusable nonuse claim:  
clothing and headgear, namely, shirts, hats, sweat pants, sweat shirts, and socks

The owner is submitting one specimen showing the mark as used in commerce on or in connection with  
any item in this class, consisting of a(n) photographs of the goods, including labels and tags, showing use  
of the mark thereon.

[Specimen File1](#)

[Specimen File2](#)

[Specimen File3](#)

[Specimen File4](#)

The registrant's current Attorney Information: Mark G. Kachigian of HEAD, JOHNSON & KACHIGIAN  
228 WEST 17TH PLACE  
TULSA, Oklahoma (OK) 74119  
United States

The registrant's proposed Attorney Information: Mark G. Kachigian of HEAD, JOHNSON &  
KACHIGIAN, P.C.

228 WEST 17TH PLACE  
TULSA, Oklahoma (OK) 74119  
United States

The docket/reference number is BAI525-182/07463-MGK.

The Other Appointed Attorney(s): Shawn M. Dellegar, Cassandra L. Wilkinson, Steven R. Tollette.

The phone number is 1 918 587 2000.

The fax number is 1 918 584 1718.

The email address is mkachigian@hjkllaw.com.

The registrant's current Correspondence Information: MARK G. KACHIGIAN of HEAD, JOHNSON & KACHIGIAN

228 WEST 17TH PLACE  
TULSA, Oklahoma (OK) 74119  
United States

The registrant's proposed Correspondence Information: MARK G. KACHIGIAN of HEAD, JOHNSON & KACHIGIAN, P.C.

228 WEST 17TH PLACE  
TULSA, Oklahoma (OK) 74119  
United States

The docket/reference number is BAI525-182/07463-MGK.

The phone number is 1 918 587 2000.

The fax number is 1 918 584 1718.

The email address is mkachigian@hjkllaw.com.

A fee payment in the amount of \$700 will be submitted with the form, representing payment for 1 class(es), plus any additional grace period fee, if necessary.

### **Declaration**

#### **Section 8: Declaration of Use in Commerce**

*Unless the owner has specifically claimed excusable nonuse, the mark is in use in commerce on or in connection with the goods and/or services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce.*

#### **Section 9: Application for Renewal**

*The registrant requests that the registration be renewed for the goods and/or services identified above.*

The undersigned being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the Owner; and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

Signature: /markgkachigian/ Date: 06/21/2012

Signatory's Name: Mark G. Kachigian

Signatory's Position: Attorney of Record, an Oklahoma Bar member  
Signatory's Phone Number: 918-587-2000

**Mailing Address (current):**

HEAD, JOHNSON & KACHIGIAN  
228 WEST 17TH PLACE  
TULSA, Oklahoma 74119

**Mailing Address (proposed):**

HEAD, JOHNSON & KACHIGIAN, P.C.  
228 WEST 17TH PLACE  
TULSA, Oklahoma 74119

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**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing Petition for Cancellation was served by First Class Mail, with sufficient postage prepaid, on this 31st day of July, 2012, upon Registrant's attorney of record:

Mark G. Kachigian, Esq.  
HEAD, JOHNSON & KACHIGIAN, P.C.  
228 West 17<sup>th</sup> Place  
Tulsa, Oklahoma 74119

BY:

  
Robert L. Epstein

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